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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

HUAWEI TECHNOLOGIES CO., LTD.,
HUAWEI DEVICE USA, INC., and
HUAWEI TECHNOLOGIES USA, INC.,

Plaintiffs / Counterclaim- Defendants,

V.

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants / Counterclaim- Plaintiffs,

and

SAMSUNG RESEARCH AMERICA

Defendant,

V.

HISILICON TECHNOLOGIES CO., LTD.,

Counterclaim-Defendant.

Case No. 3:16-cv-02787-WHO

HUAWEI'S OPPOSITION TO SAMSUNG'S MOTION TO STRIKE PORTIONS OF HUAWEI'S EXPERT REPORTS

Hearing Date: August 8, 2018

Time: 2:00 p.m.

Location: Courtroom 2, 17th Floor

Judge: Hon. William H. Orrick

**REDACTED VERSION OF DOCUMENT
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TABLE OF CONTENTS

I.	OVERVIEW.....	1
II.	BACKGROUND FACTS	1
III.	ARGUMENT	3
A.	Huawei’s Equivalents Analysis for the “Group Number k” Element in Huawei’s ’239 Patent Was Properly Disclosed.	3
B.	The Priority Date Analyses Set Forth in the Rebuttal ’587 and ’892 Expert Reports Were Timely.....	5
1.	Samsung Bears the Burden of Persuasion Concerning All Aspects of its Invalidity Defenses With Respect to the ’587 and ’892 Patents.....	6
2.	Samsung Bears the Initial Burden of Production that a Reference is Prior Art to the ’587 and ’892 Patents.....	7
3.	The Priority Date Analysis for the ’587 and ’892 Patents was Properly Included in Huawei’s Rebuttal Reports.....	7
C.	Samsung Had Sufficient Notice of Huawei’s Invalidity Analysis for the ’825 Patent.....	9
1.	“Predetermined Delay Duration.”	9
2.	Claim 4’s Structural Elements.	11
D.	Huawei Disclosed its Non-Infringement Theories for Samsung’s ’105, ’350, ’130 and ’726 Patents.	12
E.	Huawei Disclosed its Position on Non-Infringing Alternatives for the Huawei Patents-in-Suit.	15
F.	Huawei Disclosed Non-Infringing Alternatives for the Samsung Patents-in-Suit.....	19
G.	Huawei’s Inequitable Conduct Defense for Samsung’s ’105 Patent.	21
IV.	CONCLUSION	22

TABLE OF AUTHORITIES

Page(s)	
2	Cases
4	<i>Am. Calcar, Inc. v. Am. Honda Motor Co.</i> , 768 F.3d 1185 (Fed. Cir. 2014).....22
6	<i>Apple v. Samsung Elec. Co., Ltd.</i> , Case No. 11-cv-01846-LHK, 2012 WL 3155574 (N.D. Cal. Aug. 2, 2012) (cited at Br. 13)
8	<i>Biogenex Labs., Inc. v. Ventana Med. Sys., Inc.</i> , No. C 05-860JFPVT, 2006 WL 2228940 (N.D. Cal. Aug. 3, 2006).....11, 12
10	<i>Ericsson Inc. v. TCL Commc'n Tech. Holdings, Ltd.</i> , No. 2:15-cv-00011-RSP, 2017 WL 5137401 (E.D. Tex. Nov. 4, 2017)
12	<i>Fujifilm Corp. v. Motorola Mobility LLC</i> , No. 12-cv-03587-WHO, 2015 WL 757575 (N.D. Cal. Feb. 20, 2015)
14	<i>Hearing Components, Inc. v. Shure, Inc.</i> , No. 9:07-CV-104, 2008 WL 11348417 (E.D. Tex. Dec. 16, 2008)
16	<i>MediaTek Inc. v. Freescale Semiconductor, Inc.</i> , No. 11-cv-5341, 2014 WL 2854773 (N.D. Cal. June 20, 2014).....12
17	<i>MediaTek Inc. v. Freescale Semiconductor, Inc.</i> , No. 11-CV-5341 YGR, 2014 WL 690161 (N.D. Cal. Feb. 21, 2014).....9, 10, 11
19	<i>MedImmune, LLC v. PDL Biopharma, Inc.</i> , No. C 08-5590 JF (HRL), 2010 WL 760443 (N.D. Cal. Mar. 4, 2010)
21	<i>Microsoft Corp. v. I4I Ltd. P'ship</i> , 564 U.S. 91 (2011).....6
22	<i>O2 Micro Intern. Ltd. v. Monolithic Power Systems</i> , 467 F.3d 1355 (Fed. Cir. 2006).....11, 12
24	<i>PowerOasis, Inc. v. T-Mobile USA, Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008).....7, 8
25	<i>Synthes USA, LLC v. Spinal Kinetics, Inc.</i> , No. C-09-01201 RMW, 2011 WL 11709387 (N.D. Cal. Aug. 19, 2011) (cited at Br. 13)
27	<i>Tech. Licensing Corp. v. Videotek, Inc.</i> , 545 F.3d 1316 (Fed. Cir. 2008).....6, 7, 8

1	<i>Therasense, Inc. v. Becton, Dickinson and Co.,</i> 649 F.3d 1276 (Fed. Cir. 2011) (en banc).....	22
2		
3	<i>ZiliLabs Inc., Ltd. v. Samsung Elec. Co. Ltd.,</i> No. 2:14-cv-203-JRG-RSP, 2015 WL 6690403 (E.D. Tex. Nov. 1, 2015).....	20
4		
5	Statutes	
6	35 U.S.C. § 282.....	6
7	35 U.S.C. § 112.....	9, 10, 11, 12
8		
9	Other Authorities	
10	Fed. R. Civ. Proc. 26.....	16, 18, 21
11	Fed. R. Civ. Proc. 37.....	18, 19, 20
12	Patent Local Rule 3-1.....	2, 5, 7
13	Patent Local Rule 3-2.....	2
14	Patent Local Rule 3-3.....	2, 9-10, 21
15	Patent Local Rule 3-4.....	2
16	Patent Local Rule 4-2.....	1
17	Patent Local Rule 4-3.....	1, 10, 13, 14
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1 Plaintiffs and Counter-Defendants, Huawei Technologies Co., Ltd., Huawei Device USA,
 2 Inc., Huawei Technologies USA, Inc. and HiSilicon Technologies Co., Ltd. (collectively
 3 “Huawei”) oppose the Motion to Strike Portions of Huawei’s Expert Reports filed by Defendants
 4 and Counter-Plaintiffs Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.
 5 (collectively “Samsung”).

6 **I. OVERVIEW**

7 Huawei timely, thoroughly, and repeatedly disclosed the bases for its infringement and
 8 validity positions on the Huawei patents and its non-infringement and invalidity positions on the
 9 Samsung patents. These disclosures included, *inter alia*, the allegations of Huawei’s Complaint,
 10 and attached claim charts; the allegations of Huawei’s Answer to Amended Counterclaims, and
 11 attached exhibits; Huawei’s Patent Local Rule 4-2 Infringement Contentions; Huawei’s Patent
 12 Local Rule 4-3 Amended Invalidity Contentions; Huawei’s claim construction positions and
 13 filings; Huawei’s Original and Supplemental Responses to Samsung’s First, Second, Third, Fourth
 14 and Fifth Sets of Interrogatories; production of 881,555 pages of Huawei documents; and
 15 deposition testimony from 19 Huawei fact witnesses solely on technical issues in the case. All of
 16 this information was provided to Samsung prior to Huawei serving 22 separate expert reports
 17 addressing the infringement and validity of the Huawei patents and non-infringement and
 18 invalidity of the Samsung patents. Following receipt of Huawei’s expert reports, Samsung had an
 19 opportunity to depose each of Huawei’s expert witnesses on their respective reports and the
 20 complete factual record in the case.

21 This is not a case where Samsung was surprised with new facts, new arguments, or
 22 undisclosed positions. Huawei repeatedly disclosed its positions. Samsung has not been deprived
 23 of the opportunity to address, respond to, or rebut any of Huawei’s positions in this case.
 24 Samsung’s accusations to the contrary ring hollow.

25 **II. BACKGROUND FACTS**

26 Huawei filed its original complaint on May 24, 2016, asserting that Samsung devices
 27 infringed eleven of Huawei’s 4G LTE Standard Essential Patents (SEPs). ECF No. 1. The
 28 complaint included infringement charts for each of Huawei’s eleven asserted SEPs.

1 Pursuant to Patent Local Rules 3-1 and 3-2, Huawei served its disclosure of asserted claims
 2 and infringement contentions on October 24, 2016. The infringement contentions identified the
 3 asserted claims, the accused instrumentalities, theories of direct and indirect infringement, theories
 4 of infringement literally and under the Doctrine of Equivalents, priority dates for each Huawei
 5 patent, facts supporting willful infringement, and detailed claim charts. *Id.* Huawei also produced
 6 179,552 pages of documents supporting its infringement contentions.

7 Huawei answered Samsung's amended counter-complaint on November 11, 2016, denying
 8 that Huawei infringed any valid claim of the nine Samsung patents alleged by Samsung to be
 9 SEPs. ECF No. 98.

10 Pursuant to Patent Local Rules 3-3 and 3-4, Huawei served its original invalidity
 11 contentions on January 20, 2017, and supplemental invalidity contentions on September 22, 2017.
 12 The invalidity contentions identified prior art references for each of Samsung's nine asserted
 13 patents and identified additional references, grouped by subject matter, describing published art
 14 relevant to the claimed inventions. These references included 3GPP technical specifications,
 15 3GPP working group submissions, and various patents and published patent applications.
 16 Declaration of Irene Yang in Support of Huawei's Opposition to Samsung's Motion to Strike
 17 Portions of Huawei's Expert Reports ("Yang Decl."), Ex. 1 (Supplemental Invalidity Contentions,
 18 9/22/2017) at pp. 13-35.

19 Following Huawei's service of infringement contentions and invalidity contentions, the
 20 parties commenced fact discovery. Huawei served original and supplemental responses to each of
 21 Samsung's interrogatories. Specifically, Huawei served an original and six supplemental
 22 responses to Samsung's First Set of Interrogatories, an original response to Samsung's Second Set
 23 of Interrogatories, an original and two supplemental responses to Samsung's Third Set of
 24 Interrogatories, an original and one supplemental response to Samsung's Fourth Set of
 25 Interrogatories, and an original response to Samsung's Fifth Set of Interrogatories.

26 As part of fact discovery, Huawei made its witnesses available for deposition, including
 27 inventors for each of Huawei's patents, 30(b)(6) witnesses, semiconductor chip design engineers,
 28 software engineers, and testing engineers. In total, Samsung deposed 19 Huawei witnesses on

1 issues related to the technical patent case.

2 Following the close of fact discovery on March 9, 2018, the parties engaged in a meet-and-
 3 confer process that resulted in both sides serving supplemental interrogatory responses, and in
 4 Samsung providing, on June 29, 2018, additional witnesses to answer questions on 365,236 testing
 5 documents that Samsung had produced on the last day of fact discovery. After the close of
 6 discovery, Samsung also provided an additional source code witness on June 27, 2018 to answer
 7 questions that Samsung's previous 30(b)(6) witness was unprepared to answer.

8 On April 27, 2018, Huawei served eleven opening expert reports including six reports
 9 addressing Samsung's infringement of the narrowed list of Huawei patents and another five reports
 10 addressing the invalidity of the narrowed list of Samsung patents.¹ On May 25, 2108, Huawei
 11 served eleven rebuttal expert reports, including five reports addressing Huawei's non-infringement
 12 of Samsung's patents and another six reports addressing the validity of Huawei's patents.

13 Following the exchange of expert reports, Huawei made each of its expert witnesses
 14 available for deposition during the three-week expert discovery window. Samsung deposed each
 15 of Huawei's expert witnesses and was not restricted from asking any questions directed to
 16 statements made by any Huawei expert in any of their respective reports. At no point did Samsung
 17 complain that it was precluded from asking questions of Huawei's experts or that Huawei's experts
 18 were not prepared to answer the questions asked of them.

19 III. ARGUMENT

20 A. **Huawei's Equivalents Analysis for the "Group Number k" Element in Huawei's** **21 '239 Patent Was Properly Disclosed.**

22 Huawei's '239 patent describes a method and apparatus for allocating sequences into
 23 groups in a manner that minimizes inter-cell interference with mobile devices in neighboring cells.
 24 Sequences with high correlation can be grouped together to avoid interference with different
 25 groups of sequences having low correlation.

26 The asserted claims of the '239 patent require "obtaining, by ... the user equipment, a
 27 **group number k** of a sequence group allocated by the system" (claim 7) and a "sequence selecting

28 ¹ Both Samsung and Huawei analyzed Samsung's '350 and '419 patents in a single expert report.

1 unit configured to obtain a **group number k** of a sequence group allocated by the system" (claim
 2 18) (emphasis added). In the 4G LTE standards, the **group number k** is "u+1" (i.e., k = u+1).
 3 Mot., Lordgooei Decl., Ex. R at ¶ 317. [REDACTED]

4 [REDACTED] *Id.* at ¶ 336. "u," however, is generated from precursors sent from the
 5 network, and obviously, "u+1" is generated from "u" as well (by adding 1). *Id.* at ¶ 253. The
 6 claims, however, do not require receiving the "group number k" directly from the network and can
 7 cover receiving precursors and calculating the group number. *See* ECF No. 330 at 15:10-16. As a
 8 result, Samsung literally satisfies the "obtaining" element of asserted claims 7 and 18, as explained
 9 in Huawei's infringement contentions, interrogatory responses, and expert report of Dr. Venugopal
 10 Veeravalli.

11 When Huawei's expert Dr. Veeravalli filed his opening infringement report, he had limited
 12 information about Samsung's non-infringement arguments on this element. Samsung, on the last
 13 day of discovery, had only provided Huawei with a high-level, boilerplate response to
 14 Interrogatory No. 24, which requested all factual and legal bases for Samsung's contention that it
 15 did not infringe the '239 patent. *See* Yang Decl., Ex. 3 (Samsung Suppl. Resp. To Huawei
 16 Interrog. (March 9, 2018)), at p. 243. In particular, Samsung stated, with no further explanation,
 17 that, "Huawei impermissibly redefines the group number 'k' to be 'u + 1' in the standard – but of
 18 course 'u + 1' is not the group number." *Id.* In that interrogatory response, Samsung never
 19 disclosed its current assertion that "obtaining" cannot include calculating.

20 To anticipate Samsung's then unarticulated and nebulous defense, Dr. Veeravalli opined
 21 that, "[t]o the extent that Samsung denies that u + 1 is the group number k, 'u+1' is equivalent to
 22 the group number k under the doctrine of equivalents." *See* Mot., Lordgooei Decl., Ex. R at ¶ 254.
 23 Samsung now seeks to strike that opinion.

24 Samsung's expert, in his rebuttal non-infringement report, asserted that the "group number
 25 k" could not be "u+1" because the "obtaining" steps allegedly require "receiv[ing] from an
 26 external device," and "u+1" is not received directly from the system, instead having been
 27 calculated. Ex. 4 (Madisetti '239 Non-Infr. Rpt.) at ¶¶ 64-68. Samsung never previously
 28 presented this argument, in its interrogatory responses or elsewhere.

1 Consequently, Dr. Veeravalli's caution in providing a doctrine of equivalents opinion in his
 2 opening infringement report turned out to be prescient, given Samsung's lack of prior disclosure.
 3 Dr. Veeravalli's doctrine of equivalents analysis in his opening infringement report accounts for
 4 the fact that even if one accepts Samsung's incorrect and limiting reading of the claim term
 5 "obtaining" to be "receiv[ing] from an external device," receiving the precursors to "u" and "u+1"
 6 from the network is equivalent to receiving the group number itself.

7 The timeline of the parties' allegations confirms Samsung's inconsistencies. Samsung first
 8 provided the above described minimal detail about its defense relating to "u+1" at 11 p.m. on
 9 March 9, 2018, the last day of fact discovery. Huawei could not have responded with its
 10 equivalents argument before discovery closed and had no reason to even assert an equivalents
 11 argument before 11 p.m. on the last day of discovery. Samsung should not be rewarded for such
 12 discovery games, and Samsung's attempt to exclude Dr. Veeravalli's equivalents analysis relating
 13 to the group number k should be denied.

14 In any event, Samsung has not been prejudiced. Samsung had a full and fair opportunity to
 15 explain its position in Dr. Madisetti's rebuttal report and to depose Dr. Veeravalli about any and all
 16 statements in his opening report. The record confirms that Samsung brought this problem on itself
 17 by only ever stating that "of course 'u + 1' is not the group number" with no further detail about its
 18 non-infringement defense until its expert's rebuttal report. The record further confirms that Dr.
 19 Veeravalli included his doctrine of equivalents analysis in his opening infringement report, thereby
 20 providing Samsung, and its expert Dr. Madisetti, with ample opportunity to respond. Indeed, that
 21 is precisely what Dr. Madisetti did in his rebuttal non-infringement report, arguing that "u + 1" is
 22 not received from the system.

23 **B. The Priority Date Analyses Set Forth in the Rebuttal '587 and '892 Expert
 24 Reports Were Timely.**

25 Samsung's motion to strike the priority date analyses of Huawei's experts, Dr. Akl for
 26 Huawei's '587 patent and Dr. Veeravalli for the '892 patent, rests on a fundamental legal error that
 27 would improperly shift the burden of proof and create an unworkable system for expert disclosures.
 28 Huawei first disclosed the priority date for the '587 and '892 patents in its Local Rule 3-1

1 Infringement Contentions, served early in the case. *See* Yang Decl., Ex. 5, (Huawei's 3-2 Infr. 2 Contentions), at pp. 8-9. Samsung argues, however, that the service of its invalidity contentions – 3 which identified prior art that *post-dated* Huawei's claimed priority dates of the '587 and '892 4 patents – obligated Huawei to provide a priority date analysis for these patents in Huawei's opening 5 expert reports. But, as the party challenging the validity of a patent, Samsung always bears the 6 burden of proving invalidity; Samsung's motion to strike is an improper attempt to shift that burden 7 to Huawei.

8 Providing an analysis of a patent's priority date to show that a reference is not prior art is no 9 different than making any other invalidity rebuttal argument, such as why a particular prior art 10 reference fails to disclose a claim limitation. In the context of the expert report schedule in this case, 11 the proper place for such arguments is in a rebuttal report responding to an opening invalidity report. 12 Samsung's logic would lead to the absurd requirement that an expert must rebut, in an opening 13 *infringement* report, every invalidity issue raised during discovery. Tellingly, Samsung fails to cite a 14 single case requiring such disclosures (or indeed, even a case requiring a priority date analysis in an 15 opening expert report). Nor is Samsung's failure surprising, as such a requirement would be 16 contrary to both the law and the established procedure in this Court.

17 **1. Samsung Bears the Burden of Persuasion Concerning All Aspects of its 18 Invalidity Defenses With Respect to the '587 and '892 Patents.**

19 As the party challenging the validity of Huawei's patents, Samsung bears the ultimate burden 20 of proving invalidity. *See Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011) (quoting 35 21 U.S.C. § 282) ("[a] patent shall be presumed valid," and the "burden of establishing invalidity of a 22 patent . . . shall rest on the party asserting such invalidity"). In moving to strike, Samsung conflates 23 two different burdens—the burden of persuasion and the burden of production (or burden of going 24 forward). The Federal Circuit has made clear that Samsung, as the party asserting that the '587 and 25 '892 patents are invalid, *always* bears the burden of persuasion on all aspects of its invalidity defense 26 by clear and convincing evidence. *See Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 27 (Fed. Cir. 2008). Indeed, in situations where the priority date of a challenged patent pre-dates a prior 28 art reference, the Federal Circuit has expressly stated that the party asserting invalidity based on that

1 reference bears the ultimate burden of persuading the finder of fact that the patent is not entitled to
 2 that priority date. *See id.* at 1328-29 (a defendant “fail[s] to carry its ultimate burden of persuasion,
 3 and its defense of invalidity [] based on anticipation” if it cannot show “by clear and convincing
 4 evidence” that the challenged patent “is not entitled to the benefit of the earlier filing date”).

5 **2. Samsung Bears the Initial Burden of Production that a Reference is Prior
 6 Art to the ’587 and ’892 Patents.**

7 The burden of presenting evidence regarding a patent’s priority date may shift between the
 8 parties, but Samsung has the initial burden of going forward with evidence that a prior art reference
 9 is anticipating prior art to the ’587 and ’892 patents. *See id.* at 1327; *PowerOasis, Inc. v. T-Mobile*
 10 *USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008). It is only after Samsung presents such evidence
 11 that the burden of production shifts to Huawei to set forth evidence that (1) the alleged prior art does
 12 not disclose all of the elements of the asserted claim or (2) that the asserted claim is entitled to an
 13 earlier “priority date” that predates the alleged prior art. *Tech. Licensing Corp.*, 545 F.3d at 1327.

14 **3. The Priority Date Analysis for the ’587 and ’892 Patents was Properly
 15 Included in Huawei’s Rebuttal Reports.**

16 Huawei undisputedly gave Samsung notice of the priority date for the ’587 and ’892 patents
 17 in Huawei’s Local Rule 3-1 Infringement Contentions. Yang Decl., Ex. 5 (Huawei’s 3-1 Infr.
 18 Contentions). For the ’587 patent, Huawei identified December 3, 2009, the date of the original
 19 Chinese application, as the priority date. *Id.* at 9. For the ’892 patent, Huawei identified April 30,
 20 2007, the date of the original Chinese application, as the priority date. *Id.* Samsung has therefore
 21 been on notice of the ’587 and ’892 priority dates since at least October 25, 2016.

22 The rebuttal expert reports of Dr. Akl addressing the ’587 patent and Dr. Veeravalli
 23 addressing the ’892 patent properly rebutted the invalidity opinions offered by Samsung’s expert
 24 witnesses, who had the initial burden of proof. This is entirely consistent with Federal Circuit
 25 precedent and the Court’s Case Management Order. In their rebuttal opinions, Dr. Akl and Dr.
 26 Veeravalli explained that prior art asserted by Samsung’s experts does not disclose all of the
 27 elements of the asserted claims *and* that the claims of the ’587 and ’892 patents are entitled a priority
 28 date that predates at least some of the cited prior art. *See* Yang Decl., Ex. 6 (Veeravalli ’587
 Validity Rpt.), ¶¶ 241-244. This is precisely how the Federal Circuit specified that the burden of

1 production of evidence should properly shift between the parties. *See Tech. Licensing Corp.*, 545
 2 F.3d at 1327; *see also Hearing Components, Inc. v. Shure, Inc.*, No. 9:07-CV-104, 2008 WL
 3 11348417, at *1, 3 (E.D. Tex. Dec. 16, 2008) (endorsing as “timely” a rebuttal expert report
 4 analyzing the priority date of an asserted claim to disqualify a reference as prior art).

5 Samsung argues that the burden of production with respect to the priority date shifted when
 6 Samsung served its invalidity contentions on Huawei and that Huawei therefore needed to include
 7 the priority date analysis in its opening report. Mot. at 20. As an initial matter, neither of cases cited
 8 by Samsung - *PowerOasis* or *Technology Licensing* - supports or suggests that the burden of
 9 production shifts upon the service of contentions. Nor would such a requirement make any sense.
 10 Following Samsung’s logic, both Huawei’s and Samsung’s experts would also have needed to
 11 explain why the alleged prior art identified in invalidity contentions does not disclose all of the
 12 elements of the asserted claims in their opening reports, prior to seeing the actual invalidity opinions
 13 offered by Samsung’s experts, because the burdens on that issue are the same as on priority. Such a
 14 procedure not only defies logic but also defeats the purpose of having a schedule for serving
 15 “rebuttal” reports. It would be neither logical nor workable for Huawei to attempt to predict in its
 16 opening expert reports the exact prior art and analysis that Samsung’s experts would offer in
 17 presenting its invalidity case,² an issue on which Samsung bears the burden of persuasion and, in the
 18 first instance, the burden of production.

19 Furthermore, with respect to the ’587 patent, Samsung cannot credibly claim that it was
 20 unaware of the priority analysis that Dr. Akl provided in his rebuttal report, because that analysis
 21 was previously disclosed in the context of an IPR that Samsung filed on the ’587 patent. *See Yang*
 22 Decl., Ex. 18 (IPR2017-01465 – Patent Owner’s Prelim. Resp. (Paper 10)) at 8-17. In fact, this
 23 argument was, in part, the basis for the PTAB’s decision not to institute that IPR. Huawei explicitly
 24 incorporated the IPR arguments, including this priority date analysis, into its interrogatory response

25 _____
 26 ² While Samsung’s invalidity contentions are intended to provide notice of the universe of prior art
 27 that Samsung *might* eventually assert, they do not specify the prior art that Samsung or its expert will
 28 *actually* rely on at trial, nor do they indicate the exact manner in which Samsung’s expert will
 analyze such art against the asserted claims of the ’587 and ’892 patents. Moreover, while
 Samsung’s Election of Prior Art (ECF No. 263) further limits this universe, it does not preclude
 Samsung from only relying on only a subset of the elected art.

1 as to why the '587 patent was valid over the art identified by Samsung in its infringement contents.
 2 *See* Yang Decl., Ex. 13 (Huawei's 2nd Supp. Resp. to Samsung's Interrogatories No. 23) at 35.

3 With respect to the '892 patent, Samsung also cannot credibly claim that "Huawei left
 4 Samsung with no opportunity to rebut the analysis of Huawei's expert." Mot. at 22:3-4. Weeks
 5 after Huawei served its expert reports, Samsung served two supplemental expert reports specifically
 6 addressing Huawei's expert's priority analysis for the '892 patent, including one on the eve of its
 7 expert's deposition. *See* Yang Decl., Ex. 7 (Madisetti '892 First Suppl. Inf. Rpt. (June 11, 2018));
 8 *See* Ex. 8 (Madisetti '892 Second Suppl. Inf. Rpt. (June 27, 2018)). Samsung had more than ample
 9 opportunity to rebut the analysis of Huawei's expert—and indeed, did. Any alleged delay was
 10 therefore harmless.

11 For the foregoing reasons, the priority date analyses disclosed in the rebuttal expert reports
 12 of Dr. Akl addressing the '587 patent (*See* Mot., Lordgooei Decl., Ex. V at ¶¶ 62-65) and Dr.
 13 Veeravalli addressing the '892 patent (Ex. 6 (Veeravalli '892 Validity Rpt.) at ¶¶ 59-77) were
 14 timely, and Samsung's motion to strike these analyses should be denied.

15 **C. Samsung Had Sufficient Notice of Huawei's Invalidity Analysis for the '825
 16 Patent.**

17 Samsung's attacks against the opening '825 invalidity report of Huawei's expert Dr. La
 18 Porta are misplaced. Mot. at 10-12. The requirements for asserting Section 112 theories must
 19 simply "giv[e] the other party sufficient notice for it to engage in meaningful discovery and
 20 preparation of its case." *MediaTek Inc. v. Freescale Semiconductor, Inc.*, No. 11-CV-5341 YGR,
 21 2014 WL 690161, at *6 (N.D. Cal. Feb. 21, 2014). That is what happened here. Samsung had
 22 more than "sufficient notice" of Huawei's Section 112 arguments and had the opportunity to
 23 conduct expert discovery on and respond to each. *See MedImmune, LLC v. PDL Biopharma, Inc.*,
 24 No. C 08-5590 JF (HRL), 2010 WL 760443, at *3 n.3 (N.D. Cal. Mar. 4, 2010) (dismissing similar
 25 challenge because, in part, the objecting party had received "extensive expert reports with respect
 26 to the subject contentions").

27 **1. "Predetermined Delay Duration."**

28 Huawei identified "predetermined delay duration" as indefinite under its original Local

1 Rule 3-3 invalidity contentions, served January 20, 2016, its supplemental invalidity contentions
 2 served September 22, 2017, and the Local Rule 4-3 Joint Claim Construction Statement. ECF No.
 3 124. During the claim construction phase of the case, the parties identified the term
 4 “predetermined delay duration” as one of the 10 most important claim disputes, with Huawei
 5 proposing that the term meant a “delay duration provided by [the] base station.” ECF No. 124, at
 6 p. 62. Samsung argued that determining the predetermined delay duration by the base station was
 7 only a preferred embodiment and that the claims were not so limited. ECF No. 140, at pp. 14-15.
 8 In response, Huawei explained that determining the delay duration by the base station was the only
 9 embodiment disclosed, and Huawei’s proposed construction was necessary for the system to work
 10 as intended. ECF No. 149 at pp. 11-13. In other words, the ’825 patent provided written
 11 description support for the “predetermined delay duration” *only if* that term meant the delay
 12 duration was being predetermined by the base station. *Id.*

13 In its claim construction order, this Court interpreted “predetermined delay duration” to
 14 mean “determined beforehand” so as “to avoid importing limitations from the specification into
 15 the claims.” ECF No. 168 at pp. 22-24. In doing so, the Court expressly noted that this
 16 construction was broader than the ’825 patent’s written description: “the ’825 patent *nowhere*
 17 *discusses* predetermining the delay duration in any of the manners hypothesized by Samsung,” and
 18 “[i]t is unclear where the patent points to the delay duration being provided by anything other than
 19 a base station.” *Id.* at 24 (emphasis in original).

20 Samsung argues that Huawei’s identification of an indefiniteness challenge is insufficient
 21 to put it on notice of Huawei’s written description challenge. But this argument seeks to obscure
 22 the relevant facts: the Court’s claim construction order, in combination with the notice and context
 23 that Huawei provided in its Rule 3-3 invalidity contentions, and 4-3 joint claim construction
 24 statement, gave Samsung more than “sufficient notice for it to engage in meaningful discovery and
 25 preparation of its case” regarding the compliance of the Court’s construction of “predetermined
 26 delay duration” with Section 112. *MediaTek*, 2014 WL 690161, at *6.

27 Samsung’s remaining arguments—that (1) Huawei’s indefiniteness challenge failed to fully
 28 describe the written description issue and (2) the defense was waived because it was not raised in

1 claim construction—likewise ignore the notice and context of the extensive claim construction
 2 briefing on this issue. *See id.* Indeed, Huawei *did* raise the issue in claim construction briefing.
 3 ECF No. 149 at p. 13. (“The ’825 patent … describes a single way of predetermining the delay
 4 duration that is necessary in order for the invention to work.”).

5 Here, Samsung was indisputably on notice of the written description issue no later than the
 6 Court’s claim construction order, if not well before, and cannot credibly claim prejudice. *See O2*
7 Micro Intern. Ltd. v. Monolithic Power Systems, 467 F.3d 1355, 1363 (Fed. Cir. 2006) (noting that
 8 courts have “taken various positions depending on the facts of the particular case” regarding
 9 whether non-compliance with the local rules bars subsequent reliance on invalidity theories); *e.g.*,
 10 *Biogenex Labs., Inc. v. Ventana Med. Sys., Inc.*, No. C 05-860JFPVT, 2006 WL 2228940, at *4
 11 (N.D. Cal. Aug. 3, 2006) (“[T]he Court is extremely reluctant to dispose of substantive
 12 infringement claims based upon procedural defects”). Further, Samsung’s expert, Dr. Valenti, had
 13 the opportunity to provide a full rebuttal to Huawei’s expert, Dr. La Porta, on the issue, and Dr.
 14 Valenti’s report did in fact, provide a timely rebuttal. *See* Yang Decl., Ex. 11 (Valenti ’825
 15 Validity Rebuttal Rpt.) at ¶¶ 464-465. And, there was no prejudice to Samsung. Section 112
 16 invalidity contentions based upon the patent itself require minimal, if any, fact discovery. *See*
 17 *Medimmune*, 2010 WL 760443, at *3 n.3 (discussing this argument). Samsung’s motion should be
 18 denied as to the “predetermined delay duration.”

19 **2. Claim 4’s Structural Elements.**

20 Claim 4 of the ’825 patent recites various structural elements, including “signal generator,”
 21 “downlink signal processor,” and “transceiver.” Samsung’s complains that Dr. La Porta’s
 22 indefiniteness and written description arguments regarding these limitations should be dismissed
 23 as well. *See* Mot. at 10-12.

24 It was not until Samsung’s March 9, 2018 interrogatory responses, served at 11 p.m. on the
 25 last day of fact discovery, that it became clear that Samsung had an unusual interpretation of these
 26 structural claim elements. *See* Yang Decl., Ex. 3 (Samsung Suppl. Resp. To Huawei Interrog.
 27 (March 9, 2018)), at 34-36, 57-62 87-93, 270; *see* Ex. 10 (La Porta ’825 Invalidity Rep.) at ¶¶ 479,
 28 482, 500 (discussing these responses). In those eleventh-hour interrogatory responses, Samsung

1 identified source code in its own products—but no hardware elements—that it believed practice
 2 these claim limitations. In light of this new information, Dr. La Porta concluded that “signal
 3 generator” and “downlink signal processor” lacked written description (*id.* at ¶¶ 479-83), and
 4 “downlink signal processor” and “transceiver,” when considered together in the context of the
 5 claim, are indefinite, (*id.* at ¶¶ 499-501). By including these arguments, in response to Samsung’s
 6 last-minute interrogatory responses, in Dr. La Porta’s opening invalidity report, Huawei provided
 7 Samsung with prompt notice of Huawei’s invalidity theories. The absence of any prejudice to
 8 Samsung is confirmed by the fact that Samsung never complained about the now-objected to
 9 invalidity theories during expert discovery. *See MedImmune*, 2010 WL 760443, at *3. Samsung
 10 had the opportunity to respond to the invalidity theories in Dr. Valenti’s rebuttal expert report,
 11 which it did (*See* Yang Decl., Ex 11 (Valenti Rebuttal Rep.) at ¶¶ 457-63, 482-83). Samsung also
 12 had the opportunity to question Dr. La Porta about these opinions at deposition.

13 The record demonstrates that Samsung was given prompt notice mere weeks after the
 14 issues were illuminated, and any prejudice is minimal given that Section 112 invalidity contentions
 15 are based upon the patent itself and require minimal, if any, discovery. *See O2 Micro*, 467 F.3d at
 16 1363; *e.g.*, *Biogenex Labs.*, 2006 WL 2228940, at *4, *MedImmune*, 2010 WL 760443, at *3 n.3.

17 **D. Huawei Disclosed its Non-Infringement Theories for Samsung’s ’105, ’350, ’130
 18 and ’726 Patents.**

19 Samsung’s characterization of the history behind Huawei’s supplemental interrogatory
 20 responses omits key facts. As a preliminary matter, non-infringement contention interrogatory
 21 responses are not required in this Court, as the other party bears the burden of proof. *MediaTek*
 22 *Inc. v. Freescale Semiconductor, Inc.*, No. 11-cv-5341, 2014 WL 2854773, *5 (N.D. Cal. June 20,
 23 2014) (“Essentially, by propounding this interrogatory right on the heels of serving its invalidity
 24 contentions, Freescale was trying to get a preview of what MediaTek’s rebuttal report would say.
 25 The Court will not penalize MediaTek for providing its response – its expert rebuttal report – at the
 26 time appointed by the Court’s scheduling order.”). Nevertheless, Huawei sought for months prior
 27 to the close of fact discovery to meet and confer with Samsung regarding mutual supplementation
 28 on the parties’ interrogatories directed to non-infringement positions. *See* Yang Decl., Ex. 12

1 (Greenblatt Mar. 13, 2018 email to Lordgooei) at 1. Samsung refused to confer. *Id.* Thus,
 2 Huawei supplemented its non-infringement interrogatory responses to match the level of detail
 3 Samsung had provided.

4 On the final day of fact discovery, Samsung served supplemental non-infringement
 5 responses after having refused to confer with Huawei and then sought to compel Huawei to
 6 provide equivalent responses. As a compromise, Huawei offered to further supplement its non-
 7 infringement interrogatory responses. By doing so, however, Huawei made clear that it was
 8 providing its further responses solely as a courtesy and only under the condition that they not be
 9 used by Samsung to attempt to limit the scope of Huawei's experts' testimony regarding non-
 10 infringement or to strike Huawei's experts' non-infringement expert reports. *See* Yang Decl., Ex.
 11 13 (Huawei's Second Supp. Resp. to Third Set of Interrog. Nos. 23, 28) at 64-65. Samsung
 12 suffered no prejudice as the supplemental interrogatory responses were served prior to Samsung
 13 having to file its opening infringement reports.

14 The particular opinions that Samsung seeks to strike from Huawei's rebuttal non-
 15 infringement expert reports are ones that Huawei either had disclosed in its interrogatory
 16 responses—despite being under no obligation to do so and despite Samsung's vague and general
 17 infringement contentions—or that Huawei could not have anticipated. For example, Huawei's
 18 non-infringement argument for the '105 patent that the accused Huawei phones [REDACTED]

19 [REDACTED]
 20 [REDACTED]
 21 [REDACTED] Ex. 13 (Huawei's Second Supp. Resp. to Third
 22 Set of Interrog. Nos. 23, 28) at 74:9-11 (emphasis added).) Only after Samsung served Dr.
 23 Prucnal's opening '105 infringement report was Huawei able to confirm that the accused products
 24 in fact [REDACTED]

25 Huawei's other noninfringement arguments for the '105 patent – that [REDACTED]
 26 [REDACTED]
 27
 28 ³ Note, the phrase "FT pre-coded symbols" was identified by the parties in the Local Rule 4-3 Joint
 Claim Construction Statement as a disputed term (ECF No. 124), and that issue remains unresolved.

1 [REDACTED]
 2 [REDACTED]
 3 were similarly disclosed in Huawei's interrogatory responses to the best of Huawei's
 4 understanding and ability at the time. Ex. 13 (Huawei's Second Supp. Resp. to Third Set of
 5 Interrog. Nos. 23, 28) at 76:1-3 [REDACTED]
 6 [REDACTED]
 7 [REDACTED]
 8 [REDACTED]
 9 [REDACTED]

10 The challenged non-infringement arguments for the '350 patent were likewise disclosed.
 11 In its supplemental interrogatory responses, Huawei disclosed that its accused products [REDACTED]
 12 [REDACTED]
 13 [REDACTED]
 14 [REDACTED]
 15 [REDACTED]
 16 [REDACTED]
 17 [REDACTED]

18 [REDACTED] *see also id.* at 79:3-5.) Huawei's disclosure of its non-
 19 infringement positions, prior to Samsung's having to serve its opening infringement report,
 20 provided Samsung with an opportunity to address the arguments, which Dr. Prucnal did in some
 21 detail.

22 Samsung also moves to strike Huawei's contention that Dr. Prucnal has not shown that
 23 Huawei's accused devices determine a downlink transmit power. But, this argument was simply
 24 unforeseeable before Huawei received Dr. Prucnal's report. Huawei could not have known that
 25 Dr. Prucnal would fail to meet his burden of proving infringement of this element. Similarly,
 26 Samsung's argument that Huawei never disclosed that the preamble to claim 1 is limiting is belied

27
 28 ⁴ Note, the phrase "*cell-specific ratio*" was identified by the parties in the Local Rule 4-3 Joint Claim Construction Statement as a disputed term (ECF No. 124), and that issue remains unresolved.

1 by the fact that Samsung's expert, Dr. Prucnal, addressed the limiting preamble in his opening
 2 infringement report. *See* Yang Decl., Ex. 14 (Prucnal '350 Infring. Rpt.) at ¶¶ 532-43.

3 Huawei's non-infringement argument for the '130 patent was likewise disclosed to
 4 Samsung prior to Dr. Bambos serving his opening infringement report. Huawei has explained that

5 [REDACTED]
 6 [REDACTED]
 7 [REDACTED]
 8 [REDACTED]

9 [REDACTED] *See* Yang Decl., Ex. 13 at 73:4-7.

10 As to the challenged non-infringement argument for the '726 patent, it was again
 11 unforeseeable prior to Samsung's service of its opening expert report that Samsung's expert would
 12 fail to meet its burden and fail to analyze the presence or absence of the "receiver," "controller,"
 13 and "HARQ processor" elements of claim 11 in Huawei's accused products. Prior to service of
 14 Samsung's infringement expert report, Huawei did not have any information beyond Samsung's
 15 opening infringement contentions, which generically repeated the claim language without
 16 explanation. *See* Yang Decl., Ex. 15 ('726 infringement chart) at 5-6. The burden falls entirely on
 17 Samsung to set forth its infringement proofs. It is not Huawei's duty to anticipate where
 18 Samsung's opening expert reports will fail, and here, it failed to identify the claimed HARQ
 19 processor.

20 **E. Huawei Disclosed its Position on Non-Infringing Alternatives for the Huawei
 21 Patents-in-Suit.**

22 Samsung's motion to strike portions of the Huawei opening expert reports that address the
 23 lack of non-infringing alternatives to the asserted Huawei patents fails for numerous reasons. At
 24 bottom, it rests on the faulty claim that Samsung was somehow prejudiced from pursing this issue
 25 during fact discovery because Huawei's response to Samsung Interrogatory No. 35 lacked
 26 sufficient detail. Mot. at 18-19. That interrogatory requested information regarding "design-
 27 around alternatives" that "could have been utilized" in lieu of the asserted Huawei patents. Mot.,
 28 Lordgooei Decl., Ex. O at 2. Huawei's response stated that there were no such design arounds

1 because “there were no alternative proposals that solved the problems solved by Huawei’s
 2 inventions.” Mot., Lordgooei Decl., Ex. P at 22. That in and of itself answers the interrogatory.

3 Samsung now apparently contends Huawei should have specifically identified and
 4 analyzed in detail proposals that Huawei’s experts later concluded in their reports were not feasible
 5 alternatives to the Huawei patents. Mot. at 18. That, however, was not the information requested
 6 by the interrogatory. Under these facts, Samsung cannot credibly show Huawei failed to comply
 7 with Rule 26(e)(1)’s requirement to supplement discovery responses. As a result, the burden on
 8 this motion never shifts to Huawei to show any claimed failure was substantially justified or
 9 harmless.

10 Regardless, Huawei did provide responses to several of Samsung’s interrogatories
 11 information regarding the superiority of Huawei’s claimed solution over the alternatives that
 12 existed at the time of the adoption of the relevant 3GPP standards. This information was included
 13 in the responses to Interrogatory No. 20 (referenced in the supplemental response to No. 35) and
 14 No. 31 (also references No. 20). *See* Mot., Lordgooei Decl., Ex. P at 21-22; Ex. Q at 16-26; Ex. 16
 15 (Plaintiff’s First Suppl. Resps. to Defendants’ Fifth Set of Interrogs. 3/30/18) at 6-17. These
 16 disclosures provided the theories and much of the detail contained in the Huawei expert reports.
 17 Having sufficiently complied with its disclosure obligations by identifying the reasons why the
 18 Huawei solutions were superior, Huawei’s experts were free to further articulate and apply those
 19 reasons in their reports. *See Fujifilm Corp. v. Motorola Mobility LLC*, No. 12-cv-03587-WHO,
 20 2015 WL 757575, at *32 (N.D. Cal. Feb. 20, 2015) (denying motion to strike because party failed
 21 to show that expert disclosed theories not disclosed in contentions “as opposed to more specific
 22 articulations of previously disclosed ones”).

23 Indeed, in its Response to Interrogatory 20, requesting that Huawei identify indicia of
 24 commercial success, long-felt need and acclaim by the industry, Huawei provided lengthy analyses
 25 for each of the four Huawei patents. Mot., Lordgooei Decl., Ex. Q at 16-26. For example, for the
 26 ‘892 patent, Huawei explained that “other [3GPP] proposals failed to provide concrete, feasible
 27 solutions for limiting the set [of configurations], or failed to select the set that achieved the same
 28 level of performance as the set selected according to the mechanism disclosed in and claimed by

1 the ‘892 patent. As such, prior proposals failed to adequately balance the need to reduce control
 2 signaling overhead and the need to maintain high/optimal detection performance.” *Id.* at 18-19.
 3 These failings of other proposals are the same ones Huawei’s ‘892 expert, Dr. Veeravalli,
 4 discusses in his report. Mot., Lordgooei Decl., Ex. S at ¶¶ 482-87 (discussing one proposal as
 5 lacking “any concrete” solutions to these kinds of problems and another as “increas[ing] likelihood
 6 of interference”).

7 Likewise, for the ’239 patent, Huawei explained the inventors “discovered that the
 8 sequence selection technique disclosed in, and claimed by, the ’239 can prevent sequences highly
 9 correlated with the sequences of specific lengths from appearing in other sequence groups.” Mot.
 10 Ex. Q at 21. These points are then reflected in Huawei’s ’239 expert report that criticizes one
 11 alternative because it “may result in very highly correlated sequences being grouped into different
 12 groups.” Mot. Ex. R at ¶ 541.

13 For the ’587 patent, Huawei explained in its response that the patent “solves a critical
 14 problem related to carrier aggregation – providing an efficient uplink ACK/NACK feedback
 15 mechanism without adding an additional field in each piece of downlink control information
 16 ...Other proposed schemes failed to solved the problem solved by the ’587 patent, or failed to
 17 provide a solution efficiently like the invention of the ’587 patent.” Mot. Ex. Q at 22. Huawei’s
 18 ’587 expert report accordingly criticizes several other proposals – including three discussed in the
 19 response to Interrogatory No. 20 (R1-102171, R1-094208, R1-102320) – because they required
 20 use of additional overhead or otherwise did not offer efficient solutions. *See* Mot., Lordgooei
 21 Decl., Ex. T, at 301-308.

22 Finally, for the ’613 patent, Huawei explained in its response that alternative proposals
 23 wasted energy and bandwidth, and included a detailed critique of proposal R1-074653. Mot.,
 24 Lordgooei Decl., Ex. Q at 25-26. These are the same failings and same proposal Huawei’s ’613
 25 patent expert discussed in his report. Mot., Lordgooei Decl., Ex. U at ¶¶ 279-85.

26 Samsung also overlooks the fact that in a First Supplemental Response to Interrogatory 31,
 27 Huawei provided an in-depth analysis of the commercial success of each of its asserted patents and
 28 the utility and advantages of the patents over other proposals and older modes. Ex 16 (Plaintiff’s

1 First Suppl. Resp. to Defendants' Fifth Set of Interrogs, 3/30/18) at pp. 8-12.

2 And, while Samsung now complains it was deprived of an opportunity to pursue the non-
 3 infringing alternatives issue during fact discovery, it omits the fact that it served its Interrogatory
 4 No. 35 too late to receive an answer prior to the close of fact discovery.⁵ Indeed, Huawei only
 5 agreed to respond substantively to this and other interrogatories in Samsung's untimely Fifth Set of
 6 Interrogatories as part of a global agreement to resolve a number of discovery disputes between the
 7 parties. Yang Decl., Ex. 17 at (March 14, 2018 email to Greenblatt from Lordgooei) 1-2. The
 8 agreement provided Huawei would serve responses "at a level of detail similar to responses
 9 provided by Samsung to equivalent interrogatories" and that Samsung reserved its "right to move
 10 to compel at that time should Huawei's responses fail to provide the requested information." *Id.* at
 11 1-2. Huawei served its response on March 30, 2018. Mot. Ex. P. It included the statement that
 12 the information requested was more appropriate for expert discovery.⁶ Huawei heard no
 13 complaints from Samsung about the thoroughness of the response until it filed its motion to strike
 14 more than three months later.

15 The sanctions Samsung seeks under Rule 37 are available only if Samsung shows Huawei
 16 failed to meet its obligation to supplement its response having first "learned" its response was
 17 "incomplete" or "incorrect." *See* Fed.R.Civ. Proc. 26(e)(1)(a), 37(c)(1). But having entered into
 18 an agreement with Huawei on how the original supplementation was made and that it would raise
 19 any issue with the response by a motion to compel – a process that first requires compliance with
 20 Chief Magistrate Judge Spero's meet and confer requirement -- Samsung cannot now circumvent
 21 that agreement by filing a motion to strike. Finally, Samsung cannot credibly show Huawei should
 22 have "known" *before* Samsung filed its motion to strike that its supplementation was deficient
 23 based on complaints Samsung first disclosed in its motion to strike. If Samsung had an issue with
 24

25 ⁵ Samsung provides a proof of service that claims the interrogatory was served by email on February
 26 7, 2018, but service by email was not made until the next day, six days after the deadline to serve
 27 discovery requests by email. Mot. Ex. P at 21.

28 ⁶ Huawei had not served an equivalent interrogatory on Samsung in recognition that the subject
 matter was one more appropriate for expert discovery.

1 the supplementation, it had an obligation under the rules and its agreement with Huawei to
 2 promptly and straightforwardly raise it with Huawei, not wait three months to file a motion to
 3 strike after the close of expert discovery.⁷

4 **F. Huawei Disclosed Non-Infringing Alternatives for the Samsung Patents-in-Suit.**

5 Samsung's motion to strike portions of Huawei's rebuttal expert reports addressing
 6 alternative technologies to the asserted Samsung patents suffers from many of the same failings as
 7 its motion directed at the Huawei patents. Most critically, the interrogatory at issue did not ask
 8 Huawei to provide the information Samsung now complains was not disclosed. There can be no
 9 sanction for failing to provide what was not asked.

10 The information Samsung seeks to strike is directed at expert opinions concerning what
 11 acceptable alternative technology existed at the time of the adoption of the 3GPP standard that
 12 Samsung contends embodies the technology claimed in the Samsung asserted patents. The
 13 damages experts agree that this issue is one of the factors relevant to the FRAND royalty analysis.
 14 See Dkt. No. 331-20 (Leonard Opening Expert Report) at 13; Dkt. No. 331-6 (Lasinski Opening
 15 Expert Report) at 41-42. The factor assumes that once the standard is adopted, there is no way to
 16 "design around" a patent that embodies mandatory standards technology. *Id.* at 40. By contrast,
 17 Interrogatory No. 14 on which Samsung seeks its sanction is directed at "design-around or
 18 alternative technology or method ("design-around) that . . . can be used as an alternative to the
 19 claimed subject matter of the asserted(s) of the Samsung Patents-In-Suit." Mot. Ex. E at 30
 20 (emphasis added). Interrogatory No. 14 seeks information regarding whether Huawei contends
 21 there are any present-day "design-arounds" to the asserted patents. That request is irrelevant to the
 22 issue of whether there were any acceptable alternative technologies at the time of the adoption of
 23 the relevant 3GPP standard. Accordingly, any alleged failings in Huawei's response cannot be
 24 grounds to find any purported failure to supplement Interrogatory No. 14 as Samsung now
 25 demands a basis for sanctions under Rule 37.

26
 27 ⁷ Samsung admits that, for at least the '587 and '613 patents, Huawei's reference in its response to
 28 Interrogatory No. 35 to its response to Interrogatory No. 20 contains the identification of other 3GPP
 18. proposals that were discussed in portions of the Huawei expert reports it now seeks to strike. Mot. at

1 Moreover, Huawei consistently took the position that the subject matter of Interrogatory
 2 No. 14 was properly the subject of expert, not fact, discovery. Samsung never formally contested
 3 this assertion nor moved to compel a further response. For good reason. As explained in a case
 4 cited by Samsung, “expert theories need not be disclosed in response to interrogatories.” *Ericsson*
 5 *Inc. v. TCL Commc’n Tech. Holdings, Ltd.*, No. 2:15-cv-00011-RSP, 2017 WL 5137401, at *13
 6 (E.D. Tex. Nov. 4, 2017). Samsung does not contend that Huawei or any of its witnesses withheld
 7 any factual information on the subject during the fact discovery period. These facts distinguish
 8 Samsung’s motion from cases it cites. *See, e.g., Synthes USA, LLC v. Spinal Kinetics, Inc.*, No. C-
 9 09-01201 RMW, 2011 WL 11709387, at *7-8 (N.D. Cal. Aug. 19, 2011) (cited at Br. 13).

10 Nevertheless, should Huawei be found to have not supplemented its response to
 11 Interrogatory No. 14 in the manner Samsung now demands, no sanction should issue under Rule
 12 37 because both exceptions Samsung identifies to imposing sanctions under the rule are met. *See*
 13 *Apple v. Samsung Elec. Co., Ltd.*, Case No. 11-cv-01846-LHK, 2012 WL 3155574 at *4 (N.D.
 14 Cal. Aug. 2, 2012) (cited at Br. 13). *First*, as shown above, Huawei’s actions in objecting to the
 15 interrogatory on expert discovery grounds was substantially justified. *Second*, Samsung cannot
 16 now show prejudice from the discussion of non-infringing alternatives in the Huawei rebuttal
 17 reports having opened the door to the issue by raising it in its opening reports

18 Indeed, Samsung defeated portions of a similar motion in another court seeking to strike
 19 parts of its rebuttal expert report in which it first addressed non-infringing alternatives after the
 20 issue was raised in the plaintiff’s opening expert report. There the court found a party “is not
 21 prejudiced by an expert’s statements in response to its expert’s statements.” *ZiliLabs Inc., Ltd. v.*
 22 *Samsung Elec. Co. Ltd.*, No. 2:14-cv-203-JRG-RSP, 2015 WL 6690403, at *2 (E.D. Tex. Nov. 1,
 23 2015). The outcome should be no different here.

24 In each of its opening expert reports, Samsung addressed the issue of non-infringing
 25 alternatives. For each of the five asserted Samsung patents, the expert stated he was “not aware of
 26 any viable non-infringing alternative” for the asserted claims or words to that effect and then went
 27 on to criticize certain alternative technologies of the time. *See* Yang Decl., Ex. 2 (Bambos ’130
 28 Opening Infr. Report) at ¶¶ 975-76; *id.*, Ex. 14 (Prucnal ’105 Opening Inf. Report) ¶¶ 706-07; *id.*,

1 Ex. 9 (Valenti '825 Opening Infr. Report) at ¶ 926; *id.*, Ex. 2 (Bambos '726 Opening Infr. Report)
 2 at ¶¶ 975, 977; *id.*, Ex. 14 (Prucnal '350 Opening Inf. Report) at ¶¶ 706, 708. Huawei in its
 3 rebuttal reports responded to those statements, as it was entitled to do, by identifying alternative
 4 technology to the asserted Samsung patents and by otherwise addressing the issues raised by
 5 Samsung's experts. Fed. R. Civ. Pro. 26(a)(2)(D)(ii); *see* Mot., Lordgooei Decl., Ex. J (Mahon
 6 '105 Non-Infr. Rebuttal Expert Report) at ¶¶ 149-57; Mot., Lordgooei Decl., Ex. K (LaPorta '825
 7 Non-Infr. Rebuttal Report) at ¶¶ 265-70; Mot., Lordgooei Decl., Ex. L (Akl '350 Non-Infr.
 8 Rebuttal Report) at ¶¶ 263-66; Mot., Lordgooei Decl., Ex. M (Mahon '130 Non-Infr. Report) at ¶¶
 9 137-40; Mot., Lordgooei Decl., Ex. N (Fuja '726 Non-Infr. Rebuttal Report) at ¶¶ 228-30.

10 None of the cases cited by Samsung directs a different result. None involves the situation
 11 here in which the opening reports opened the door to the issue of non-infringing alternatives.
 12 Likewise, Samsung's statements regarding which party bears the burden of proving non-infringing
 13 alternatives during the "accounting" or "damages period" are irrelevant to the issue of what
 14 alternative technologies were available at the earlier time of the adoption of the standard. That
 15 issue goes to the FRAND damages calculation and is one that Samsung, as the proponent of its
 16 FRAND damages claim, addressed for its asserted patents in its opening damages report.
 17 Samsung's expert report cited technical expert reports and conversations its damages expert had
 18 with its technical experts as the basis for its conclusions that there were no acceptable technologic
 19 alternatives at the time of the adopted of the relevant standards. Dkt. No. 331-20 (Leonard
 20 Opening Expert Report) at 35-41. Once Samsung raised the issue of the absence of alternative
 21 technologies in its opening expert reports, Huawei was entitled to respond in its rebuttal reports.
 22 Those actions are not grounds to strike any portion of Huawei's expert rebuttal reports.

23 **G. Huawei's Inequitable Conduct Defense for Samsung's '105 Patent.**

24 Huawei alleged inequitable conduct for Samsung's '105 patent in its Patent Local Rule 3-3
 25 supplemental invalidity contentions, served on September 22, 2017. *See* Yang Decl., Ex. 1 at p.
 26 109. The allegation was premised, in part, on the fact that neither Samsung nor inventor Farooq
 27 Khan provided any prior art references to the Patent Examiner during prosecution of the '105
 28 application, as shown on the face of the patent. *Id.* at p. 111-113. In its supplemental invalidity

1 contentions, Huawei explained that neither Samsung nor Mr. Khan provided the Patent Examiner
 2 with Working Group papers from the 3GPP TSG RAN Working Group meeting held in Beijing,
 3 China in April 2005, that were material to the '105 patent. *Id.* Huawei's invalidity contentions
 4 explained that both Samsung and Mr. Khan attended the meeting and had access to the Working
 5 Group papers distributed at the meeting. *Id.* The most reasonable inference from this
 6 circumstantial evidence is that Mr. Khan and Samsung withheld material information from the
 7 Patent Examiner with the intent to deceive. *See Am. Calcar, Inc. v. Am. Honda Motor Co.*, 768
 8 F.3d 1185, 1190–91 (Fed. Cir. 2014) (“We recognize instead that ‘[b]ecause direct evidence of
 9 deceptive intent is rare, a district court may infer intent from indirect and circumstantial evidence,’
 10 provided that such intent is the single reasonable inference.”) (citing *Therasense, Inc. v. Becton,*
 11 *Dickinson and Co.*, 649 F.3d 1276, 1290-91 (Fed. Cir. 2011) (en banc)).

12 Following service of the supplemental invalidity contentions, Huawei proceeded with
 13 discovery to determine whether there were sufficient facts to plead inequitable conduct with the
 14 requisite particularity. Based upon a review of the deposition testimony, the documents produced
 15 by Samsung in the case, and the expert report of Dr. Paul Min, Huawei has concluded that the
 16 record facts do not support a pleading of inequitable conduct defense with the required
 17 particularity. As a result, Huawei will not be proceeding with a defense of inequitable conduct on
 18 the '105 patent.

19 **IV. CONCLUSION**

20 For the foregoing reasons, Huawei respectfully requests that each of Samsung's requests to
 21 strike portions of Huawei's expert reports be denied.

22
 23 Dated: July 17, 2018

Respectfully submitted,

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